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ARLINGTON, VIRGINIA 22209-9889

In re Application of: Mizuno
Application No. 10/764,600
Filed: January 27, 2004
For: STORAGE SYSTEM

**DECISION ON PETITION
TO MAKE SPECIAL
(ACCELERATED EXAMINATION)
UNDER M.P.E.P. §708.02 (VIII)
AND 37 C.F.R. §1.102(d)**

This is a response to the petition filed November 09, 2004, under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02 (VIII): Accelerated Examination, to make the above-identified application special.

The Petition is **DISMISSED**.

M.P.E.P. §708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. §1.102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (a) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
- (b) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status;
- (c) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. The pre-examination search must be directed to the invention as claimed in the application for which special status is requested. A search made by a foreign patent office satisfies this requirement;
- (d) Submits one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and
- (e) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

In those instances where the request for this special status does not meet all the prerequisites set forth above, **petitioner will be notified and the defects in the request will be stated**. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, petitioner will be given one opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed

petitions to make special may or may not be considered at the discretion of the Group Special Program Examiner.

The petition filed November 09, 2004 fails to adequately meet requirement (e) of the criteria set forth above.

With respect to requirement (e), a complete detailed discussion of the aforementioned most closely related references has not been provided with the necessary specificity required under 37 CFR 1.111 (b) and (c), with respect to independent claim 16. Petitioner's submission is deficient in that it merely paraphrases one or two paragraphs of each reference (as in the discussion of U.S. Patent Application No. 2004/0148479, which paraphrases paragraph 20) accompanied by a single statement that the references do not include certain features of the claimed invention. Many of the limitations of claim 16 do not appear to have been discussed, including, for example, a proxy device. In addition, the main feature alleged to be absent from the prior art is not actually claimed. For example, "...where the controller controls the device to *temporarily* store block data..." (line 3, page 5 of the petition) is not recited in the claims.

That is, the submission does not satisfy the requirement, as it does not provide a *detailed discussion* of the references and it does not point out how the *claimed subject matter is patentable over the references*. Petitioner should ensure that the above discussion is directed to how the language of *each of* the independent claims is specifically distinguishable and patentable from the references provided in requirement (d) above.

Petition to Make Special **DISMISSED**.

Petitioner is given one opportunity to perfect the petition. Any request for reconsideration must be filed within TWO MONTHS of the mail date of this decision.

Until the renewed petition is submitted, the application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.



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